

13 JAN 2003



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WASHINGTON, D. C. 20231
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In re Application of	:	
DUBOIS	:	DECISION ON
Application No.: 09/194,996	:	
PCT No.: PCT/FR97/01024	:	RENEWED PETITION
Int. Filing Date: 10 June 1997	:	
Priority Date: 11 June 1996	:	UNDER 37 CFR 1.47(b)
Attorney's Docket No.: 146.1309	:	
For: TRANSDERMIC SYSTEMS . . .	:	
MEDICAMENTS	:	

This decision is in response to applicant's facsimile transmission on 13 December 2002, which has been treated as a petition under 37 CFR 1.181. The petition requests that the "RENEWED PETITION UNDER 37 C.F.R. 1.47(b)" and the declaration of Jean-Claude Vieillefosse submitted with the petition under 37 CFR 1.181 be accepted as having been filed with the USPTO on 16 July 2002. No petition fee is due.

BACKGROUND

On 10 June 1997, applicant filed international application PCT/FR97/01024, which claimed a priority date of 11 June 1996. A copy of the international communication was communicated to the United States Patent and Trademark Office from the International Bureau on 18 December 1997. A Demand for international preliminary examination in which the United States was elected, was filed on 31 December 1997, prior to the expiration of nineteen months from the priority date. Accordingly, the thirty-month period for paying the basic national fee in the United States expired at midnight on 11 December 1998.

On 04 December 1998, applicant filed, in the United States Patent and Trademark Office (USPTO), a transmittal letter requesting entry into the U.S. national stage, which was accompanied by, *inter alia*, the requisite U.S. basic national fee and an unexecuted declaration.

On 20 April 1999, the USPTO mailed applicant a NOTIFICATION OF MISSING REQUIREMENTS (PCT/DO/EO/905) and a NOTIFICATION OF A DEFECTIVE OATH OR DECLARATION (PCT/DO/EO/917) which indicated that the oath or declaration was not properly executed, and set a one month time period for response.

On 20 September 1999, applicant filed a "COMPLETION OF APPLICATION". The submission included, *inter alia*, a petition under 37 CFR 1.47(b); a declaration by the 37 CFR 1.47(b) applicant on behalf of and as agent for the non-signing inventors; a "Declaration Under

Rule 47" by Jean-Claude Vieillefosse (hereinafter "first declaration of facts"); and Exhibits A-F:

- Exhibit A, a declaration of designation of inventors signed by Mr. Dubois;
- Exhibit B, copy of French law;
- Exhibit C, copy of employment contract;
- Exhibit D, copy of letter written to Mr. Dubois on 09 November 1998;
- Exhibit E, copy of fax to Mr. Dubois sent on 02 December 1998; and
- Exhibit F, copy of letter forwarded to Mr. Dubois on 30 December 1998.

On 14 February 2000, the USPTO mailed a decision dismissing applicant's petition under 37 CFR 1.47(b). Specifically, the decision noted that the following had not been provided: factual proof that the inventor refuses to execute the application; a statement of the last known address of the inventor; an oath or declaration by the 37 CFR 1.47(b) applicant on behalf of and as agent for the non-signing inventor; and proof that the 37 CFR 1.47(b) applicant has sufficient proprietary interest in the application.

On 21 March 2000, applicant filed a renewed petition under 37 CFR 1.47(b). The renewed petition was accompanied by a "Supplemental Declaration Under Rule 47" by Jean-Claude Vieillefosse.

On 23 March 2000, applicant filed a "Supplement to the Renewed Petition" accompanied by an "Extract from the minutes of the Board of Executive Directors' deliberations dated Thursday 10 December 1998 at 2:00PM" and an English translation thereof.

On 26 July 2000, the USPTO mailed a decision dismissing applicant's renewed petition under 37 CFR 1.47(b). Specifically, the decision noted that the following had still not been provided: a statement of the last known address of the inventor; an oath or declaration by the 37 CFR 1.47(b) applicant on behalf of and as agent for the non-signing inventor; and proof that the 37 CFR 1.47(b) applicant has sufficient proprietary interest in the application.

On 03 August 2000, applicant filed a second renewed petition under 37 CFR 1.47(b).

On 14 December 2000, the USPTO mailed a decision dismissing applicant's second renewed petition under 37 CFR 1.47(b). Specifically the decision noted that proof that the 37 CFR 1.47(b) applicant has sufficient proprietary interest in the application had still not been provided.

On 12 January 2001, applicant submitted a third renewed petition, which was accompanied by a declaration of Jean-Claude Vieillefosse.

On 17 May 2001, the USPTO mailed a decision dismissing applicant's third renewed petition under 37 CFR 1.47(b). Specifically, it was again noted that proof that the 37 CFR 1.47(b) applicant has sufficient proprietary interest in the application had still not been provided.

On 06 July 2001, applicant submitted a fourth renewed petition.

On 14 December 2001, the USPTO mailed a decision dismissing applicant's fourth renewed petition under 37 CFR 1.47(b). Specifically, it was again noted that proof that the 37 CFR 1.47(b) applicant has sufficient proprietary interest in the application had still not been provided.

On 02 May 2002, applicant submitted a facsimile transmission, which was treated as a petition under 37 CFR 1.181. The petition requested that the "RENEWED PETITION UNDER 37 C.F.R. 1.47(b)" and the declaration of Jean-Claude Vieillefosse submitted with the petition under 37 CFR 1.181 be accepted as having been filed with the USPTO on 08 February 2002. The submission was accompanied by a copy of a date-stamped postcard receipt.

On 16 May 2002, the USPTO mailed a decision granting applicant's petition under 37 CFR 1.181 but dismissing applicant's renewed petition under 37 CFR 1.47(b). Specifically, it was again noted that proof that the 37 CFR 1.47(b) applicant has sufficient proprietary interest in the application had still not been provided.

On 13 December 2002, applicant submitted the instant facsimile transmission, which has been treated as a petition under 37 CFR 1.181. The petition requests that the "RENEWED PETITION UNDER 37 C.F.R. 1.47(b)" and the declaration of Jean-Claude Vieillefosse submitted with the petition under 37 CFR 1.181 be accepted as having been filed with the USPTO on 16 July 2002. The submission was accompanied by a copy of a date-stamped postcard receipt.

DISCUSSION

Petition Under 37 CFR 1.181

Applicant has provided sufficient evidence to establish that on 16 July 2002 applicant filed the documents listed above. The proof is in the form of the copy of the postcard receipt for the above-identified application which bears a USPTO date stamp of 16 July 2002 and which itemizes the documents listed above and identifies the above-captioned application number and docket number. Further, practitioner's statement on the cover page of the facsimile transmission is construed as meaning that the copies of the documents filed 13 December 2002 are true copies of the documents originally filed 16 July 2002. (If this interpretation is incorrect, applicant must *immediately* notify the Office of PCT Legal Administration of such fact.) Therefore, in view of the postcard receipt and practitioner's statement, the documents received on 13 December 2002 may properly be accepted as originally received in the USPTO on 16 July 2002.

Renewed Petition Under 37 CFR 1.47(b)

A petition under 37 CFR 1.47(b) must be accompanied by: (1) the fee under 37 CFR 1.17(h), (2) factual proof that the inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the inventor, (4) an oath or declaration by the 37 CFR 1.47(b) applicant on behalf of and as agent for the non-signing

inventor, (5) proof that the 37 CFR 1.47(b) applicant has sufficient proprietary interest in the application, and (6) a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damage. It was noted in the decision mailed 14 February 2000 that applicant has satisfied items (1) and (6) above. The decision mailed 26 July 2000 noted that applicant has also satisfied item (2). The decision mailed 14 December 2000 indicated that items (3) and (4) had also been satisfied. All of the decisions indicated that item (5) had not been met.

Regarding item (5), the decision mailed 16 May 2002 indicated that it had not been established that the employee was performing an inventive task which corresponded to his actual duties or was performing studies and research with which he had been explicitly entrusted. Applicant has provided another declaration of facts by Jean-Claude Vieillefosse. This declaration is sufficient to establish that the 37 CFR 1.47(b) applicant has sufficient proprietary interest in the application. Also regarding item (5), the relationship between Aventis Pharma, Hoechst Marion Roussel and Roussel Uclaf has been explained and proof of the relationship has been provided. A new declaration by Aventis Pharma on behalf of and as agent for the non-signing inventor is not required. Accordingly, item (5) has been satisfied.

CONCLUSION

For the above reasons, applicants' renewed petition under 37 CFR 1.47(b) is **GRANTED**.

As provided in 37 CFR 1.47(b), a notice of the filing of this application will be forwarded to the non-signing inventor at his last known address of record.

A notice of the filing of the application under 37 CFR 1.47(b) will be published in the Official Gazette.

Any further correspondence with respect to this matter should be addressed to the Assistant Commissioner for Patents, Box PCT, Washington, D.C. 20231, with the contents of this letter marked to the attention of the Office of PCT Legal Administration.

This application is being forwarded to the National Stage Processing Branch of the Office of PCT Operations to continue national stage processing of the application, including the accordation of a 371(c) date of **20 September 1999**.



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In re Application of
DUBOIS

Application No.: 09/194,996

PCT No.: PCT/FR97/01024

Int. Filing Date: 10 June 1997

Priority Date: 11 June 1996

Attorney Docket No.: 146.1309

For: TRANSDERMAL SYSTEMS CONTAINING TWO ACTIVE PRINCIPLES IN
SEPARATE COMPARTMENTS, THEIR METHOD OF PREPARATION AND
APPLICATION AS MEDICINE

Dear Mr. Dubois:

You are named as an inventor in the above-captioned United States national stage application, filed under the provisions of 37 CFR 1.47(b) and 35 U.S.C. 116. Should a patent be granted, you will be designated as an inventor.

As a named inventor, you are entitled to inspect any paper in the file wrapper of the application, order copies of all or any part thereof (at a prepaid cost per 37 CFR 1.19) or to make your position of record in the application. Alternatively, you may arrange to do any of the preceding through a registered patent agent or attorney presenting written authorization from you. Joining in the application would entail the filing of an appropriate oath or declaration by you pursuant to 37 CFR 1.63.

A handwritten signature in black ink, appearing to read "Daniel Stemmer".

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